UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,078	10/31/2003	Graham Christopher Oxland Murray	111708.02	9735

25944	7590	06/10/2005

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EXAMINER
ALI, MOHAMMAD ·

ART UNIT	PAPER NUMBER
2167	

DATE MAILED: 06/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

Office Action Summary	Application No.	Applicant(s)
	10/697,078	MURRAY, GRAHAM CHRISTOPHER OXLAND
	Examiner	Art Unit	
	Mohammad Ali	2167	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _31 October 2003_.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-10_ is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) _1-10_ is/are rejected.
7)☒ Claim(s) _1-10_ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
    1.☐ Certified copies of the priority documents have been received.
    2.☐ Certified copies of the priority documents have been received in Application No. _____.
    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _10/31/03_.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

U.S. Patent and Trademark Office
PTOL-326 (Rev. 1-04)   Office Action Summary   Part of Paper No./Mail Date 06082005

DETAILED ACTION

1.   This communication is in response to the continuation application filed on

10/31/03.

The application has been examined and claims 1-10 are pending in this Office

Action.

Claim Objections

2.   Claim 1 is objected to because of the following informalities: "A method or

organizing information" should be corrected as "A method for organizing information".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claims 1 - 10 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Claim 1 recites the limitation "A method" in claim. There is insufficient

antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

4.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

Claims 1 - 10 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter.

MPEP 2106 IV.B.2.(b)

A claim that requires one or more acts to be performed defines a process. However, not
all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460.
To be statutory, a claimed computer-related process must either: (A) result in a physical
transformation outside the computer for which a practical application in the technological arts is
either disclosed in the specification or would have been known to a skilled artisan, or (B) be
limited to a practical application within the technological arts.

Claims 1 - 10, in view of the above-cited MPEP sections, are not statutory

because they merely recite a number of computing steps without producing any tangible

result and/or being limited to a practical application within the technological arts. The

use of a computer has not been indicated.

Theses claim do not indicate use of hardware on which the software runs to

perform the steps recited in the body of the claim. Software or program can be stored

on a medium and/or executed by a computer. In other words the software must be

computer-readable. The use of a computer is not evident in the claim. MPEP

2106.IV.B.1(a) refers to "computer-readable" medium with computer program encoded

on it."

Double Patenting

5.   A rejection based on double patenting of the "same invention" type finds its
support in the language of 35 U.S.C. 101 which states that "whoever invents or
discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis

added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer <u>cannot</u> overcome a double patenting rejection based upon 35 U.S.C. 101.

6.   Claims 1-10 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-9 of prior U.S. Patent No. 6,694,329. This is a double patenting rejection.

The following table shows the claims in 10/697,078 that are rejected by corresponding claims in 6,694,329.

Claims Comparison Table

	10/697,078	6,694,329
Claims	1,7	1
	2	2
	3	3
	4	4
	5	5
	6	6
	8	7

<table>
<tr><td>9</td><td>8</td></tr>
<tr><td>10</td><td>9</td></tr>
</table>

Claim Rejections - 35 USC § 103

7.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8.   Claims 1-6, and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable

over US Patent 4,905,163 issued to Garber et al. ('Garber' hereinafter) in view of

Horvitz et al. ('Horvitz' hereinafter), USP 6,262,730.

As to claim 1, Garber discloses a method of organizing information into a concept

network, creating an explicit model of the thinking processes of a person or community

of people that facilitates the creation an sharing of knowledge (Abstract, lines 1-21).

Garber teaches 'categorizing ideas and thoughts into concepts' as information

description storage for storing information comprising a plurality of concepts and for

each concept knowledge of allowable attributes for the concept and one or more of

attributes, attribute values, and relationships among attributes and attribute values. The

system further comprises categorization knowledge storage for storing knowledge of

criteria for placing the concepts into categories and context determination for

determining a current context based on system state (Abstract, lines 5-14). Further,

teaches 'creating links between concepts' as once a focal concept has been selected,

the Focus system generates a list of related concepts which represent perspectives of

the focal concept which could be made available to the user. If the focal concept has a

related-concepts slot such as related-concept slot, it will accessed to generate a list of

related concepts. An alternative method of generating a list will be used if the focal

concept has links to sub-classes of related concepts (col. 39 lines 50-67). Garber

teaches 'assigning link attributes to each link between concepts, each attribute having a

direction' as once a focal concept has been selected, the Focus system generates a list

of related concepts which represent perspectives of the focal concept which could be

made available to the user. If the focal concept has as related-concepts slot such as

related-concept slot, it will accessed to generate a list of related concepts. An

alternative method of generating a list will be used if the focal concept has links to sub-

classes of related concepts (col. 39 lines 50-67). Garber teaches 'categorizing

information into objects' as categorization knowledge storage for storing knowledge of

criteria for placing the concepts into categories and context ('object') determination for

determining a current context based on system state (Abstract, lines 10-14). Garber

teaches 'categorizing objects into concepts' as dynamic categorization for dynamically

placing the concepts into categories for presentation using the categorization criteria,

the current context and the knowledge of mappings and for displaying on a user screen

selected concepts and categories (Abstract, lines 17-21). Garber teaches 'assigning

object attributes to each object' categorizing information into objects' as categorization

knowledge storage for storing knowledge of criteria for placing the concepts into

categories and context ('object') determination for determining a current context based

on system state (Abstract, lines 10-14). Garber teaches 'creating links between objects'

as once a focal concept has been selected, the Focus system generates a list of related

concepts which represent perspectives of the focal concept which could be made

available to the user. If the focal concept has a related-concepts slot such as related-

concept slot, it will accessed to generate a list of related concepts. An alternative

method of generating a list will be used if the focal concept has links to sub-classes of

related concepts (col. 39 lines 50-67). Finally, Garber teaches 'assigning link attributes

to each link between objects,...' as once a focal concept has been selected, the Focus

system generates a list of related concepts which represent perspectives of the focal

concept which could be made available to the user. If the focal concept has a

related-concepts slot such as related-concept slot, it will accessed to generate a list of

related concepts. An alternative method of generating a list will be used if the focal

concept has links to sub-classes of related concepts (col. 39 lines 50-67 et seq).

Garber does not explicitly indicate claimed knowledge acquisition.

Horvitz discloses claimed knowledge acquisition (user's knowledge is influenced

by the previous help that user may have seen. The user's background and previous

help are variables that can be stored in a persistent file and updated with time. Such

persistent information about user background, experience, and competence is referred

to as "profile information." Several classes of action may be available to the system,

including the providing of advice or help, the execution of software actions of various

kinds and the acquisition of additional, previously unobserved information from the system,or directly from the user (see col. 20, lines 16-35, Horvitz).

It would have been obvious to one ordinary skill in the data processing at the time of the present invention to combine the teachings of the cited references because knowledge acquisition of Horvitz's teaching would have allowed Garber' system to provide assistance to software users and to optimize the functionality of computer systems and software by performing inference about users needs and preferences in the operation of software systems or applications as suggested by Horvitz at col. 1, lines 11-15, Horvitz.

As per claim 2, Garber teaches 'the calculation of link attribute values' at col. 8 lines 1-26. Garber teaches 'the colculation of object attribute values' at col. 8 lines 1-26 et seq. Further Garber teaches 'selecting and ranking objects based on any mathematical function using the link or object attribute values' at col. 39 lines 51-67 et seq. Finally, Garber teaches 'locating information relevant to any object by evaluating direct object links between that object and directly linked objects, and indirect object links and concept links affecting that object' at col. 34 lines 26-67, col. 8 lines 1-26.

As per claim 3, Garber teaches 'the degree of 'relevance' of any other object to a given object is assessed by calculating the strength of the relationship between the given object and the other object, by summing the strength of any direct link between the objects and the strengths of any indirect' at col. 29, lines 50-67 et seq.

As per claim 4, Garber teaches 'one or more of the objects or concepts represent goals for an organization to which the concept network relates, the organization may

have an overall purpose, and each object and concept within the concept network is

evaluated as having an importance value relative to each goal, and each goal has an

importance value relative to the organisational purpose' at col. 29, lines 50-67 et seq.

As per claim 5, Garber teaches 'the importance values are used to allocate

resources to the various goals with a view to optimising the success of the overall

organisational purpose' at col. 8 lines 1-26 et seq.

As per claim 6, Garber teaches 'the concept network takes into account the

following changes in the network over time the purpose of the organization, the degree

of existence of any object, the properties of links between concepts, and the strength of

links between objects' at col. 39, lines 10-67 et seq.

As per claim 8, Garber teaches 'an object has associated with it one or more

performance measures' at col. 8, lines 1-26.

As per claim 9, Garber teaches 'success and risk values are associated with

Objects' at col. 8 lines 1-26.

As per claim 10, Garber teaches 'the personal agent determines information

which is relevant to bring to the attention of its associated person based on one or more

of importance, performance, risk, success and action priority values associated with

each object In the concept network, and the personal agent pro-actively seeks input

from its associated person concerning he status and completion of tasks' at col. 39 lines

10-67 et seq.

Allowable Subject Matter

9.   Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph and 101, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The prior art or record does not teach or suggest wherein concept network includes accountable objects, which are directly or indirectly accountable for other objects, and wherein an action priority rating for an accountable object is calculated by evaluating the importance of each object for which the accountable object is accountable; the degree of accountability between the accountable object and each object; the extent to which the accountable object has addressed all issues and actions associations with each object and the time which has elapsed since the accountable object last considered each object; risk and success value with associated with each object.

Contact Information

10.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Mohammad Ali whose telephone number is (571) 272-

4105. The examiner can normally be reached on Monday-Thursday (7:30 am-6:00 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number

for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Mohammad Ali
Primary Examiner
Art Unit 2167

MA
June 8, 2005